

REMARKS

Claims 1-68 are currently pending, claims 1, 10, 19, 28, 37, 47, 56 and 63 being amended.

Claim Amendments

Independent claims 1, 10, 19, 28, 37, 47, 56 and 63 have been amended to recite a skim coat that has, *inter alia*, a binder present in an amount of between about 1.0% and about 4.0% by weight, a mineral filler having a D50 between about 5 and about 35 µm, and a polymeric noncellulosic thickener, wherein the coating formulation does not contain any cellulosic thickener.

Support for these changes may be found throughout the specification. For example, support for the binder being present in an amount of about 1 to about 4 wt% may be found in paragraph [0027]. Support for the filler having a D50 of about 5 to about 35 µm may be found in paragraph [0023]. Support for the noncellulosic thickener being a polymeric noncellulosic thickener may be found in paragraph [0030]. And, support for the coating formulation not containing any cellulosic thickener may be found in paragraph [0029] and the Examples (see Tables 1 and 2), wherein the coating formulation does not contain any cellulosic thickener for either Example.

Double Patenting

Claims 1-36 and 56-68 stand provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-36 and 56-68 of copending Application No. 10/823,419. Applicants respectfully traverse this rejection.

Claims 37-55 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 37-55 of copending Application No. 10/823,419. Applicants respectfully traverse this rejection.

Application No. 10/8823,419 has been abandoned. Accordingly, there are no conflicting claims that are pending.

Withdrawal of the double patenting rejections is respectfully requested.

§ 103 Rejection

Claims 1-68 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zuber (WO 02/012144) in view of Attard (USPN 5,336,318). Applicants respectively traverse this rejection.

Independent claims 1, 10, 19, 28, 37, 47, 56 and 63 have been amended by to recite a skim coat that has, *inter alia*, water, a binder present in an amount of between about 1.0% and about 4.0% by weight, a mineral filler having a D50 between about 5 and about 35 µm, and a polymeric noncellulosic thickener, wherein the coating formulation does not contain any cellulosic thickener.

A combination that includes the claimed skim coat is not taught or suggested by Zuber. Zuber discloses systems comprising skim coated prefabricated elements and jointing material. The skim coat and the jointing material comprise a mineral filler, a binder and water. No polymeric noncellulosic thickener is present in the corresponding compositions. When a thickening agent is indeed provided (termed "handling agent", see page 9, third paragraph), it is only a cellulosic thickener (namely methylhydroxyethylcellulose).

Therefore, Zuber does not disclose using a skim coat from a coating formulation comprising a polymeric noncellulosic thickener and not containing any cellulosic thickener.

As detailed in the Amendment of March 8, 2007, in response to the Official Action of December 8, 2006, as clear to one skilled in the art, there is no teaching or suggestion to use the joint compound formulation (or elements thereof) of Attard for a skim coat. Attard relates to a clay-free, asbestos-free and microbubble-free drying type *joint compound*. That is, Attard only teaches a *jointing compound* with a thickener and *not* a skim coat with a thickener. One skilled in the art would not have been taught or motivated to use the thickener of the joint compound of Attard in the skim coat of Zuber.

Further, Attard does not remedy the deficiencies of Zuber. Attard discloses a drying-type joint compound based on a mineral filler, a binder and water. The joint compound also comprises a blend of thickeners, namely a **cellulosic thickener** in association with an acidic acrylate copolymer *in situ* thickener.

Therefore, even if one skilled in the art had used the teachings of the joint compound of Attard for designing a skim coat formulation (which the applicants

maintains one skilled in the art would not have, at least because a drying-type joint compound is a paste-like material unsuitable for coating purposes) she would not have achieved the claimed invention because none of the cited prior art teaches the use a polymeric noncellulosic thickener at the exclusion of any cellulosic thickener. As recalled in Attard (column 1, lines 63-65), most of the thickeners conventionally used are cellulosic thickeners. Attard itself teaches the use a cellulosic thickener in association with a non-cellulosic thickener. See abstract and column 4, lines 10-14 ("the in-situ thickeners should be used in combination with the cellulosic thickeners instead of as replacements therefor"). As a result, Attard specifically teaches away from the claimed invention.

The presence of a polymeric noncellulosic thickener and the absence of any cellulosic thickener in the coating formulation of the claimed invention provides embodiments of the present invention that achieve a level 5 finish without application of a final coat. This is not possible if a cellulosic thickener is used, because the present inventors have found that a cellulosic thickener favors the appearance of so-called "orange peel" on the surface (i.e. the appearance of numerous small bumps and indentations).

In view of the above, all claims are non-obvious in view of the cited prior art. Withdrawal of the rejection of claims 1-68 as being unpatentable over Zuber in view of Attard is respectfully requested.

Conclusion

Accordingly, in view of the foregoing amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw all of the objections and rejections.

In the event that there are any questions concerning this amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By:

T.D. Boone

Travis D. Boone

Registration No. 52635

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620